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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,223	05/22/2000	Nicholas Anthony John Peach	140/238 [UK999-051]	2229
47939	7590	10/06/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ LLP (IBM YORKTOWN)			REVAK, CHRISTOPHER A	
1990 M STREET, NW				
SUITE 800			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20036-3425			2131	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/576,223	PEACH, NICHOLAS ANTHONY JOHN	
	Examiner	Art Unit	
	Christopher A. Revak	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on July 11, 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-7 and 11 is/are allowed.
- 6) Claim(s) 12 and 16-21 is/are rejected.
- 7) Claim(s) 8-10,13-15 and 18-21 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 April 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

Response to Arguments

1. In view of the appeal brief filed on July 11, 2005, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Specification

2. Claims 8-10,13-15, and 18-21 are objected to because of the following informalities:

In claim 8, line 8, the word "sea" is recited that which appears to by a typographical error.

In claim 14, line 8, after the limitation "belonging to said sealing" appears to be incomplete.

In claim 18, line 2, it is recited of "the e steps" which needs to be corrected.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 16-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite of a "computer product" that is not tangibly embodied and is software alone and of itself.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross et al, U.S. Patent 5,553,143.

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As per claim 16, it is disclosed by Ross et al of a computer product storing instructions for execution on a computer to perform a process to validate a digital file constituting a license (contract). A header package is included in the digital file along with rules (col. 17, lines 31-40 and col. 18, lines 13-18). The rules keys are used to determine if the header package and sealed package forming a contract of a digital file is valid (col. 11, line 65 through col. 12, line 6; col. 12, lines 55-58; and col. 18, lines 13-18). Each sealed package is validated using the keys (col. 11, lines 65 through col. 12, line 6 and col. 17, lines 31-40).

As per claim 17, Ross et al teaches of performing additional steps of obtaining keys from a network server identified by the rules (col. 16, lines 42-46 and col. 17, lines 31-40).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt et al, U.S. Patent 6,067,531 in view of Fukui, U.S. Patent 5,930,357.

Hoyt et al discloses of a contract management apparatus comprising means for accepting and securely storing data files constituting contracts in a secured (encrypted package) database and means for backing up the package database (see abstract, col.

2, lines 14-18 & 40-45). A browser (navigator tool) adapted to allow a user access to the stored data files constituting the contracts (col. 4, lines 53-64). Responsive to a request for a secured (encrypted package) from the database, for transmitting the package to an external entity (see abstract). The teachings of Hoyt et al are silent in disclosing of means for informing users of data files having expiring contracts in the database and means for deleting contracts from the database. The teachings of Fukui disclose of means for informing users of data files having expiring contracts in the database and means for deleting contracts from the database (as shown in Figure 2 and col. 5, lines 15-21 & 35-42). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply means for informing users of expiring contracts. Fukui recites of motivation for informing users of expiring contracts by disclosing that a licensor can confirm if a user is not illegally using a program according a contract (col. 1, lines 45-49). It is obvious that the teachings of Hoyt et al would have found this feature of Fukui beneficial in that a licensor would know if the contract has expired, then according deleting it.

Allowable Subject Matter

9. Claims 1-11,13-15, and 18-21 are allowed.
10. The following is a statement of reasons for the indication of allowable subject matter:

As per claims 1,8, and 14, it was not found to be taught in the prior art of a header package having rules defining sealed packages produced by a sealing party, a

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body containing a validating signature generated from the rules and the body according to a first key belonging to a validating party, and a sealed signature generated from the header package and the sealed packages according to a second key belonging to the sealing party.

As per claim 11, it was not found to be taught in the prior art of means for obtaining a header package for a contract, reading rules defining sealed data packages and for identifying a sealing party and any sealed package included in the contract, means for generating a sealing signature from the header package of any of the sealed packages according to a first key belonging to the sealed party, and means for assembling the header package, sealed packages, and the sealing signature into a digital file constituting a contract.

As per claim 18, it was not found to be taught in the prior art of storing rules to describe a data package, creating a data package from the rules and merging the rules and the data package into a merged file. A validity signature is created from the merged file to prevent unauthorized use of the digital file. A unique number is generated for identifying the file, and merging the validity signature, merged file, and unique number to creating a sealing signature from the merged files and sealing the merged files with the sealing signature to produce a sealed package.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

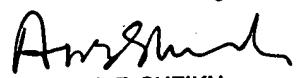
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Revak
Primary Examiner
AU 2131


10/2/05

CR

October 2, 2005


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